

REMARKS

The application, having been granted a priority date under 35 U.S.C. §119 of 12 May 2000 derived from France patent application 00480043.9, was filed in the United States on 24 April 2001 with ten claims. In the first Examiner's Office Action mailed 02 January 2004, the Examiner objected to the abstract, rejected claims 1-10 and claims 4-5 under 35 U.S.C. §112, second paragraph, and rejected claims 1-10 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,920,316 entitled TASKBAR WITH START MENU to Oran et al. (Oran '316) in view of U.S. Patent No. 5,515,496 entitled COMPUTER SYSTEM WITH DIRECT MANIPULATION INTERFACE AND METHOD OF OPERATION SAME to Kaehler et al. (Kaehler '496). In response, Applicant amended the specification and the claims and added new claims 11-20.

The Examiner responded on 02 July 2004 with a final rejection of the claims. The Examiner rejected claims 1-10 under 35 U.S.C. §112, first ¶, asserting that the claim language "each focus buoy [is] not visible when its respective window is not visible." does not comply with the written description requirement. The Examiner also rejected claim 11 under 35 U.S.C. §112, second ¶, saying there was insufficient antecedent basis for the limitation "focus buoy." The Examiner also finally rejected claims 1, 2, 4-9 and 16-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,939,507 entitled VIRTUAL AND EMULATED OBJECTS FOR USE IN THE USER INTERFACE OF A DISPLAY SCREEN OF A DISPLAY PROCESSOR to Beard et al. (Beard '507) in view of Kaehler '496 in further view of U.S. Patent No. 4,868,765 entitled PORTHOLE WINDOW SYSTEM FOR COMPUTER DISPLAYS to Diefendorff (Diefendorff '765). The Examiner further issued a final rejection of claims 3 and 10 under 35 U.S.C. §103(a) as being unpatentable under Beard '507, Kaehler '496, Diefendorff '765 in view of Oran '316; claims 11 and 13 under §103(a) over Beard '507 in view of Diefendorff '765, claims 12 and 15 under §103(a) over Beard '507 in view of Diefendorff '765 in further view of Kaehler '496; and claim 14 under §103(a)

over Beard '507, Diefendorff '765, Kaehler '496 and Oran '316. In a response mailed 02 September 2004, Applicant amended claims 1, 11-15. The Examiner sent an Advisory Action on 03 November 2004 stating that he did not enter the amendments because "each focus buoy being displayed at a location on or beside its respective window only when the respective application is open" allegedly introduced new matter. Applicant responded by filing a Request for Continued Examination on 19 November 2004. The Examiner entered the amendments of the response 02 September 2004 and continued to examine the application.

In the Examiner's Action mailed 10 February 2005, under 35 U.S.C. §103(a), the Examiner rejected claims 1, 2, 4-9, and 16-20 in view of Beard '507, Kaehler '496, and Diefendorff '765; claims 3 and 10 in view of Beard '507, Kaehler '496, Diefendorff '765 and Oran '316; claims 11 and 13 in view of Beard '507 and Diefendorff '765; claims 12 and 15 in view of Beard '507, Diefendorff '765 and Kaehler '496; and claim 14 in view of Beard '507, Diefendorff '765, Kaehler '496, and Oran '316. In response, Attorney for Applicant takes note of the fact that the Examiner repeated the rejections of the claims using the same references as he did in the final rejection. No new art was found for the alleged "new issues." Claims 3 and 12 are amended, claims 11 and 13 are canceled. Claims 1-10, 12, 14-20 are pending.

The Rejection of claims 1, 2, 4-9 and 16-20 under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 2, 4-9 and 16-20 as being obvious over Beard '507 in view of Kaehler '496 and Diefendorff '765.

Beard '507 teaches a desktop showing a plurality of icons, such as icon 68 in Figure 4 of Beard '507. When the icon is opened by, e.g., clicking a mouse, a window is opened on the desktop revealing a directory listing objects contained in the folder; at the top of the open window is a header having a title position 108 which the Examiner states is a "little window." When the application is minimized, the "little window" either moves to the task bar; and when another window of another

application is opened on top of the first window, the “little window” is removed from sight. The Examiner states in the rejection on page 2 of the Examiner’s Action, that Figure 5, Element 108, i.e., the title position, is analogous to the claimed focus buoy that encapsulates a “little window”; and on the other hand the Examiner states at page 14, bottom paragraph of the Examiner’s Action, that an icon 68 is analogous to the claimed focus buoy. Applicant is not sure how the Examiner is applying Beard ‘507.

Kaehler ‘496 teaches a method to change modes of an icon - from invoking tasks using the icon (use mode) or changing affordances of an icon (edit-and-use mode). An affordance pertains to a quality of the button or icon itself that can be modified, Kaehler ‘496 at column 3, lines 4-5. A “halo of affordances” are the edit handles (*see* column 6, line 35) whereby a user can change, e.g., the size of the icon; the position of the icon; the script of the tasks associated with the icon; the name of the icon; the style and/or font of the icon; the image of the icon; delete the icon, etc. The “halo of affordances” associated with a button/icon can be made to appear by gesturing the mouse, i.e., by wiggling the mouse on/near the select box of an object. In other words, by wiggling the mouse and then selecting a particular edit handle, the button/icon itself can be modified.

Diefendorff ‘765 teaches a porthole window system wherein a porthole to a hidden window appears on the top window; the porthole showing the contents of the hidden window. The porthole of Diefendorff ‘765 “can be considered to be a small opening made in an upper layer window in order to see through into an underlying window. The important fact is that the view through the porthole window is precisely what would be seen in the corresponding portion of the underlying window if such underlying window were fully exposed.” (*see* Diefendorff ‘765 at column 3, lines 35-42).

The Examiner asserts that “[i]t would have been obvious to one of ordinary skill in the art to use Kaehler’s teaching and modify Beard, to include an option where the user has to wiggle the mouse to instigate an action of displaying all the

buoys, or icons, or order to give the user the ability to see all the open windows without having to click any of the mouse buttons and for easier and quicker selection.”

Applicant traverses this presumption again - neither Beard ‘507 nor Kaehler ‘496, absent the Examiner’s hindsight, suggest their combination; and their combination does not yield Applicant’s claimed invention. As stated before, no matter how hard you shake a mouse over the icon of Beard ‘507, Kaehler ‘496 teaches that you can only modify the icon, not open a window associated with the icon - simple as that. Neither Beard ‘507 nor Kaehler ‘496 teach that by shaking a mouse, you can change focus to an open application.

The Examiner admits as such by relying on Diefendorff ‘765 to teach “portholes.” The Examiner asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Beard ‘507 and Kaehler ‘496 with the teachings of Diefendorff ‘765 and include the ability to show parts of the screen that would otherwise be hidden by other windows with the motivation to allow the user to easily and quickly obtain information about what is displayed on the screen.”

Again, Applicant rebuts the Examiner’s assertion and suggests that the Examiner is using his hindsight as motivation for the combination because none of the references suggest their combination with the other. It is well known and still good law that an Examiner is not free to pick and choose different features from the prior art and then provide his own motivation for their combination to yield the claimed invention - the combination must be suggested by the references themselves.

Applicant further rebuts the Examiner’s assertion of obviousness because even if the references were combined, Applicant’s claimed invention would not be the result. Shaking a mouse that actually modifies the actual button/icon as described by Kaehler ‘496 on the icon/button of Beard ‘507 will only modify the icon

- not invoke a plurality of portholes as taught by Diefendorff '765 to show the user all open applications as taught by Applicant.

With regard to claims 2-9, it is irrelevant whether Beard '507 has a table for the displayed windows or contains a message box, otherwise known as a little window, or that a user wiggles or shakes the mouse to make the icons appear or disappear because the icons of Beard '507 are visible on the desktop whether its associated application is open or not. The Examiner refers to Beard '507 at column 3, lines 14-21 wherein the "user interface on the display screen includes metaphoric symbols with which the user can interact with by using the input means to selectively change the focus of the input means to a designated symbol visually pointed to via the input means to thereafter permit manipulation of the designated symbol or interaction with data input/output relative to the designated symbol." The Examiner uses Applicant's teaching in combination with his hindsight to assert that Beard '507 teaches that ANY action, including removing the focus buoys, or icons, displayed on the screen are taught by Beard '507. Beard '507 at column 11, lines 34 through column 12, line 14 provides only that "mouse pointer button held in its down position"; "moving the cursor pointer with button still held in its down position ... at this point, if button is released by the user Other commands for performing functions ... may be invoked from keyboard." Throughout Beard '507, references are made to holding down mouse buttons or keyboard entries - no where is it suggested that windows of open applications can be brought to the forefront by merely shaking a mouse. Absent Applicant's teaching and Examiner's hindsight, shaking a mouse on the button/icon of Beard will not change the focus of a plurality of open applications.

Addressing the rejection of claims 16-20, Applicant traverses because Beard '507 does not teach element (c) "creating at least two focus buoys on the display subsystem" nor element (e) of claim 16, "layering the at least two windows so that the underlying windows and the respective focus buoys are partially or completely not visible to a user" The Examiner refers to Figure 12, Elements 126 and 130 of

Beard '507 for showing focus buoys associated with and located on the open windows. Element 126 is a device bar and element 130 is a command bar (*see* Beard '507 at column 19, line 5); these are not focus buoys as claimed. Respectfully, Applicant requests the Examiner to clarify what he considers to be analogous to the claimed focus buoys. Is the icon 68 of Figure 4, Beard '507 the focus buoy? Or is the title position 108 of Figure 5, Beard '507 the focus buoy? Or is the device bar 126 of Figure 12, Beard '507 the focus buoy? Or is the command bar 130 of Figure 12, Beard '507 the focus buoy? In any event, shaking a mouse over an icon, or over a title position, or over a device bar, or over a command bar for the purpose of changing affordances or characteristics of a the icon/position/device bar/command bar does not teach the claimed method of displaying all underlying focus buoys. Similarly, there is no motivation in fact to refer to these icons or title positions or device bars or command bars as portholes because shaking a mouse over them do not cause a display subsystem to change focus.

Respectfully, Applicant requests the Examiner to allow claims 1-2, 4-9, and 16-20 because neither Kaehler '496 nor Deifendorff '765, alone or in combination, provide the teachings to Beard '507 to create a focus buoy and display it only when its respective application is open.

The Rejection of claims 3 and 10 under 35 U.S.C. §103(a)

The Examiner rejected claims 3 and 10 under 35 U.S.C. §103(a) under Beard '507 (windowing system with icons), Kaehler '496 (shaking a mouse), Diefendorff '765 (portholes on stacking windows) and Oran '316. Applicant amended claim 3; in doing so, Applicant did not add new matter. Support in the originally filed specification for the amendment is given on page 4, lines 28-30. Amended claim 3 addresses alternative locations of the focus buoy displayed an any location on the window or even beside the window if the focus buoys are layered on top of each other; and claim 10 teaches that when the mouse is shaken, the windows disappear and only the focus buoys appear.

Oran '316 teaches an anchored taskbar that includes visual indicators for each application that has an active window. By clicking on one of the visual indicators of an open application, a user invokes a pullup/pulldown context menu for the particular application from which to choose several options, such as to "close," "minimize," or "maximize" the application and/or window. In Oran '316, the taskbar is always anchored at a fixed location on the user interface, *see* Oran '316 at column 5, lines 10-11.

Applicant respectfully traverses because the taskbar of Oran '316 is fixed and so must the visual cues on the taskbar; the visual cues cannot be displayed at any location of the window, as claimed. The taskbar of Oran '316 is always visible so there is no need to shake a mouse over a visual indicator on the taskbar to see which applications are open: a user can already see which applications are open. Again, without Applicant's teaching and the Examiner's imagination, shaking a mouse (Kaehler '496) on an icon (Beard '507) will not make the icon appear on a window or in an alternative location - it will only allow a user to change the features of the icon - even if the icon is hidden through a porthole (Diefendorff '765) and/or located on a fixed taskbar (Oran '316). Moreover, there is no reason to apply Oran '316 to Beard '507 because the icons of Beard '507 don't need alternative locations, they are always visible when the desktop is visible, whether an application is open or not. Further, in contrast to both Oran '316 and Beard '507 and Kaehler '496, Applicant's focus buoys are located all over the display, *see, e.g.*, Figure 2D of Applicant's application. The fixed positioning of the icons at taskbar (Oran '316) and outside the window of an open application (Beard '507) are not compatible with the alternative memory locations of claim 3. Still further, the features of the Beard '507 and the Oran '316 references having positions of icons independent of the application are inconsistent with layered windows having portholes of Diefendorff '765 and with shaking an input device to make the portholes appear as in Kaehler '496. Respectfully, Applicant requests the Examiner to withdraw the rejection of claim 3 because none of the references teach, "a focus

buoy being displayed only when its respective application is open” and Oran ‘316 does not teach that a focus buoy might be “displayed at any location of the window or beside the window”

With respect to claim 10, none of the references suggest that merely shaking a mouse can make the windows pertaining to open applications disappear but leave their focus buoys displayed. Oran ‘316 states that a context menu may have a menu option to “Minimize All Windows” option [that] minimizes all currently open windows so that they appear as taskbar buttons on the taskbar.” Oran ‘316 teaches that a user has to click a button on a mouse to open a menu on a fixed taskbar and then select an option to minimize all windows. Oran ‘316 does not teach that merely shaking or wiggling a mouse over indicators on a fixed taskbar will minimize all open applications - why would there be any reason to do this?

The Rejection of claims 11 and 13 under 35 U.S.C. §103(a)

Applicant cancels claims 11 and 13 without disclaimer or prejudice.

The Rejection of claims 12 and 15 under 35 U.S.C. §103(a)

The Examiner rejected claims 12 and 15 under 35 U.S.C. §103(a) under Beard ‘507 (windowing system with icons), Kaehler ‘496 (shaking a mouse), Diefendorff ‘765 (portholes on stacking windows), and Oran ‘316 (opening context windows to change the appearance of the desktop).

Applicant has amended claim 12 to incorporate all the limitations of claim 11. Applicant further asserts that the combination of Beard ‘507, Kaehler ‘496, and Oran ‘316 do not teach the creation of a focus buoy when an application is opened, and that Diefendorff ‘765 does not provide the teaching for the focus buoys of the underlying windows to appear and disappear. The portholes of Diefendorff ‘765 cannot be made to reappear merely by wiggling a mouse after they are closed, either after a period of time or by closing the application.

The Rejection of claim 14 under 35 U.S.C. §103(a)

The Examiner rejected claim 14 under 35 U.S.C. §103(a) under Beard '507 (windowing system with icons), Kaehler '496 (shaking a mouse), and Diefendorff '765 (portholes on stacking windows). Applicant traverses as above. Nothing suggests that windows can be removed by merely shaking a mouse, as claimed in claim 14. Regardless of whether an application/window is open, the icons on a desktop are visible whenever the desktop is displayed in Beard '507, similarly with Kaehler '496. Shaking a mouse only permits a user to change the icon itself, not make a focus buoy appear or disappear. Respectfully, the combination of Beard '507, Kaehler '496, Diefendorff '765, with or without Oran '316, does not render Applicant's claim 14 obvious because, first, the icons, the command bars, the title positions, the device bar of Beard '507 and the halo of affordances of Kaehler '496 and the visual cues of Oran '316 are not the focus buoys on its respective window. Whenever the desktop is visible, the icons of Beard '507 and Kaehler '496 are visible, regardless of whether the application or object associated with the icon is open. The taskbar of Oran '316 is always visible so any visual cue of an open application is also always visible. Regardless of how many applications are open as shown on the taskbar of Oran '316, shaking a mouse anywhere on the display subsystem will not make any focus buoys appear or disappear quite honestly, Attorney for Applicant is bewildered at how to respond; how to imagine the alleged combination posited by the Examiner. The portholes of Diefendorff '765 are not icons, they are not focus buoys, they are not visual cues on a taskbar - I cannot imagine how to put these four references together in any sensible combination.

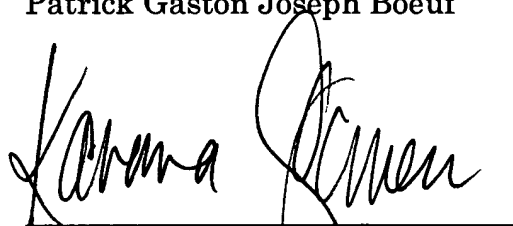
Conclusion

Applicant continues to traverse the rejections proffered by the Examiner because their combination is not suggested by anything other than the benefit of Applicant's teachings and Examiner's imagination. Applicant requests the Examiner to reconsider the rejections in view of the remarks above and to allow the claims. The Examiner is respectfully invited to telephone the Attorney listed below if he thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,
Patrick Gaston Joseph Boeuf

Date: 10 May 2005

By



Karuna Ojanen
Registration No. 32,484
(507) 282-0049 voice
(507) 281-5722 fax

IBM Corporation
Intellectual Property Law Dept. 917
3605 Highway 52 North
Rochester, MN 55901-7829